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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,974	08/28/2001	Wayne Lewis Dickerson JR.	END920010076US1	6358

23550 7590 02/28/2007		EXAMINER
HOFFMAN WARNICK & D'ALESSANDRO, LLC		LOFTIS, JOHNNA RONEE
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14TH FLOOR	ART UNIT	PAPER NUMBER
ALBANY, NY 12207	3623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/940,974	DICKERSON, WAYNE LEWIS
	Examiner	**Art Unit**	
	Johnna R. Loftis	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 December 2006</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>23-33</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>23-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 12/8/06 has been entered.

DETAILED ACTION

2.   The following is a non-final office action upon examination of application number

09/940,974. Claims 23-33 are pending and have been examined on the merits discussed below.

Response to Arguments

3.   Applicant's arguments filed 12/8/06, regarding rejections under 35 USC 112, 1st

paragraph, have been fully considered but they are not persuasive. Applicant contends that the

specification enables one of ordinary skill in the art to practice the invention. Examiner points

out that the claims are directed identifying a solution to improve a business value of a company

including a specific industry, but the specification does not cover all possible embodiments.

While the specification mentions one example in a grocery store, one of ordinary skill in the art

would not be able to identify and assess impact of all possible solutions for an unlimited number

of industries. The specification, while being enabling for identifying and assessing solutions in

the grocery store industry, does not reasonably provide enablement for every possible industry.

The specification does not enable any person skilled in the art to which it pertains, or with which

it is most nearly connected, to practice the invention commensurate in scope with these claims.
Prior rejections under 35 USC 112, 1st paragraph are upheld.

With respect to prior rejections under 35 USC 112, 2nd paragraph, Applicant's arguments
have been considered but are not found to be persuasive. Since there are no guidelines pointing
to which operational metrics are identified, if one of ordinary skill in the art identifies a metric
such as employment rate (which inherently is used to measure health or viability of a company),
one cannot guarantee that a solution to the employment rate will necessarily improve the
business value. If the employment rate is low, a solution may be to increase. However, if by
hiring, the company is bringing in unskilled workers needing training, business value may not
necessarily improve. Prior rejections under 35 USC 112 2nd paragraph are upheld.

4.   With respect to prior rejections under 35 USC 101, Applicant's arguments have been
considered but are not found to be persuasive. For a claimed invention to statutory, the claimed
invention must produce a useful, concrete and tangible result. The claimed invention is not
useful because one cannot necessarily improve the business value of a company by carrying out
the steps of the body of the claim. Since there are endless potential metrics that could be
identified, some may affect business value and some may not. The invention lacks concreteness
since the metrics that are set forth are directed to potential problem areas wherein the established
metrics may not correlate with problems revealed through the gap analysis. It is also not
concrete since the claims are directed to brainstorming, in a sense, to come up with potential
solutions to potential problem areas without setting forth an objective methodology explaining
how to identify solutions for hypothetical problems. Since there is no real world result and the

identified solution is not implemented, the invention is also not tangible. Prior rejections under

35 USC 101 are upheld.

5.   Regarding prior rejections under 35 USC 103(a), Applicant argues Machin and Sanders

separately. In response to applicant's arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, Applicant argues that

Sanders does not teach rendering solutions to an industry. Examiner points out that ultimately

the claimed invention is directed to identifying a solution to improve a business value of a

company *in* an industry. In Sanders, a company, or enterprise, identifies solutions to improve a

business value. Inherently, those solutions would be applicable by other businesses within that

industry. Prior rejections under 35 USC 103(a) in view of Machin and Sanders are upheld.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

7.   Claims 23-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. The claim(s) contains subject matter which was not described in

the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. Specifically, it is not clear

how one would go about assessing the impact of each solution. The metrics or problems

identified, along with the solutions, are hypothetical based on the industry. The number of

metrics and solutions for a given industry is endless. There is nothing in the specification that

clearly sets forth steps one would take that would enable one to assess the impact of all possible

solutions.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention. Specifically, it is not clear what

the conflict resolution rules are and it is not clear how they are implemented in such a way to

determine a solution.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

9.   Claims 23-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The body of the claim does not meet the objective of the claim preamble. It is not

clear how identifying a solution to address exposed performance gaps will result in improving

the business value of company. While some operational metrics may affect a company's

business value, there are many other factors such as market stability, employment rate, etc., that

will affect the business value of a company. Clarification is requested.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.   For a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. The claimed invention is not useful since there is utility lacking. One cannot necessarily improve the business value of a company by carrying out the steps of the body of the claim. While some operational metrics may affect a company's business value, there are many other factors such as market stability, employment rate, etc., that will affect the business value of a company. The claimed invention is not concrete since the metrics that are set forth are directed to potential problem areas wherein the established metrics may not correlate with the problems revealed through the gap analysis. In addition the claims lack concreteness since the claims are, in a sense, directed to brainstorming to come up with potential solutions to potential problems. There is no objective methodology explaining how to identify solutions to problems that don't necessarily exist. Additionally, the claimed conflict resolution rules are not repeatable since there are no guidelines or explicitly methodology set forth in the specification that would enable one of ordinary skill in the art to select a solution that has a positive impact on one metric but a negative impact on another solution.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claims 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machin et

al, US 6,877,034, in view of Sanders, US 6,411,936.

As per claim 23, Machin et al teaches identifying operational metrics for the industry,

wherein the operational metrics includes a factor used to measure health or viability of a generic

company in the specific industry (figs. 12 and 13 – a set of metrics are identified to evaluate a

call center – these metrics inherently measure health or viability of the call center); assembling a

set of solutions for application for a specific industry, wherein the set includes one of decision,

an action, a product and a service (Since Machin et al is set up so that one can independently log

in to the system and perform the gap analysis wherein the set of solutions is pulled from a

database, it seems that these solutions associated with industry metrics are set forth prior to any

gap analysis taking place. Based on the industry, in the example given it is a call center, a set of

metrics is established. Once the gap analysis is performed on each of the metrics, a printout of a

summary of potential solutions available on the market for narrowing or eliminating that gap is

presented. These solutions must be previously set forth based on the metrics for the specific

industry); comparing current operational performance of the company to an operational

performance of another company within the industry to expose performance gaps (column 11,

line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the

performance gap between the requesting user and a peer group); and identifying a solution based

upon the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap

versus solution optimizer report takes each metric and comes up with a summary of potential

solutions; then estimates the impact of the solution on the performance gap and ranks the

solutions in descending order with the best solution at the top; see fig 14 also - for each

performance gap, based on the metrics, an optimal decision index is calculated based on cost to

implement, time to implement, risk to implement and return on investment to implement – that

with the lowest optimal decision index is the best proposed solution for that performance gap

(column 13, lines 22-27)) and outputting the solution from the computer system (see fig 14), but

does not explicitly teach assessing impacts of application of the solutions on operational metrics

prior to any comparison between companies. However, Sanders teaches a continuous closed

loop process wherein enterprise value enhancement solutions are updated based on feedback

information. Sanders teaches a performance processor is used to compile a set of solutions that

are mapped to causals and functions of the enterprise (column 14, lines 10-65). The globally

networked total solution system of Sanders delivers value enhancement through solutions sets

most appropriate for execution by specific functions for delivery of enhanced value (column 6,

lines 57-60). Regression or other similar analysis is used to determine the highest confidence

measure of success for particular solutions (column 14, lines 15-25). Therefore, it would have

been obvious at the time of the invention to incorporate the established solutions of Sanders into

Machin et al's gap analysis system to provide recommended solutions and best practices for

industry metrics that can be easily accessed based on the gap analysis. The access of the

established solutions would simplify and quicken the gap analysis procedure.

As per claim 24, Machin et al teaches the industry includes call centers (additionally

teaching that every type of business benefits from benchmarking) but does not teach a retail store

industry, a grocery store industry or an accounting professional service industry. However, these

limitations merely recite various intended uses of the invention. A recitation of the intended use

of the claimed invention must result in a structural difference between the claimed invention and

the prior art in order to patentably distinguish the claimed invention from the prior art. If the

prior art structure is capable of performing the intended use, then it meets the claim. In a claim

drawn to a process of making, the intended use must result in a manipulative difference as

compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136

USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a

structural difference between the claimed invention and the prior art nor in a manipulative

difference as compared to the prior art; therefore, the claimed invention is not deemed to be

patentably distinct over the prior art.

As per claim 25, Machin et al teaches the operational metrics include at least one of rate

of inventory turnover and a number of customers per day (see fig. 9 – metric includes inbound

calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included).

As per claim 26, Machin et al teaches applying conflict resolution rule when a solution

has a positive or negative impact on the metric (see fig 14. and column 12, lines 16-30 – the gap

versus solution optimizer looks at each gap and each solution and estimates the impact of the

solution on the performance gap) and determining which solution should be implemented

(column 12, lines 16-30; column 13, lines 22-26 – determines which solution is optimal).

As per claim 27, Machin et al teaches benchmarking a company process or function on an

articulated basis (column 13, lines 28-35), but does not explicitly teach repeating the steps

automatically at a scheduled interval. Official notice is taken that it would have been obvious to

one of ordinary skill in the art at the time of the invention to repeat the steps automatically at a

scheduled interval as a way to monitor the company's performance. By automatically repeating

at scheduled intervals, the benchmarking process of Machin et al, the company would be more

aware of it's performance based on the benchmarking calculations leading to a more accurate

view of the company's performance.

As per claim 28, Machin et al teaches the another company is a best in class company

(column 3, lines 26-34 – benchmarking involves comparing the vital statistics of one enterprise

against those of a peer group).

As per claim 29, Machin et al teaches identifying operational metrics for the industry,

wherein the operational metrics includes a factor used to measure health or viability of a generic

company in the specific industry (figs. 12 and 13 – a set of metrics are identified to evaluate a

call center – these metrics inherently measure health or viability of the call center); assembling a

set of solutions for application for a specific industry, wherein the set includes one of decision,

an action, a product and a service (Since Machin et al is set up so that one can independently log

in to the system and perform the gap analysis wherein the set of solutions is pulled from a

database, it seems that these solutions associated with industry metrics are set forth prior to any

gap analysis taking place. Based on the industry, in the example given it is a call center, a set of

metrics is established. Once the gap analysis is performed on each of the metrics, a printout of a

summary of potential solutions available on the market for narrowing or eliminating that gap is

presented. These solutions must be previously set forth based on the metrics for the specific

industry); comparing current operational performance of the company to an operational

performance of another company within the industry to expose performance gaps (column 11,

line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the

performance gap between the requesting user and a peer group); generating a value proposition

by identifying a solution based on the impacts to address the exposed performance gaps (column

12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a

summary of potential solutions; then estimates the impact of the solution on the performance gap

and ranks the solutions in descending order with the best solution at the top; see fig 14 also – for

each performance gap, based on the metrics, an optimal decision index is calculated based on

cost to implement, time to implement, risk to implement and return on investment to implement

– that with the lowest optimal decision index is the best proposed solution for that performance

gap (column 13, lines 22-27)) and outputting the value proposition from the computer system

(see fig 14), but does not explicitly teach assessing impacts of application of the solutions on

operational metrics prior to any comparison between companies. However, Sanders teaches a

continuous closed loop process wherein enterprise value enhancement solutions are updated

based on feedback information. Sanders teaches a performance processor is used to compile a

set of solutions that are mapped to causals and functions of the enterprise (column 14, lines 10-

65). The globally networked total solution system of Sanders delivers value enhancement

through solutions sets most appropriate for execution by specific functions for delivery of

enhanced value (column 6, lines 57-60). Regression or other similar analysis is used to

determine the highest confidence measure of success for particular solutions (column 14, lines

15-25). Therefore, it would have been obvious at the time of the invention to incorporate the

established solutions of Sanders into Machin et al's gap analysis system to provide

recommended solutions and best practices for industry metrics that can be easily accessed based

on the gap analysis. The access of the established solutions would simplify and quicken the gap

analysis procedure.

As per claim 30, Machin et al teaches identifying operational metrics for the industry,

wherein the operational metrics includes a factor used to measure health or viability of a generic

company in the specific industry (figs. 12 and 13 – a set of metrics are identified to evaluate a

call center – these metrics inherently measure health or viability of the call center); assembling a

set of solutions for application for a specific industry, wherein the set includes one of decision,

an action, a product and a service (Since Machin et al is set up so that one can independently log

in to the system and perform the gap analysis wherein the set of solutions is pulled from a

database, it seems that these solutions associated with industry metrics are set forth prior to any

gap analysis taking place. Based on the industry, in the example given it is a call center, a set of

metrics is established. Once the gap analysis is performed on each of the metrics, a printout of a

summary of potential solutions available on the market for narrowing or eliminating that gap is

presented. These solutions must be previously set forth based on the metrics for the specific

industry); comparing current operational performance of the company to an operational

performance of another company within the industry to expose performance gaps (column 11,

line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the

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12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a

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and ranks the solutions in descending order with the best solution at the top; see fig 14 also – for

each performance gap, based on the metrics, an optimal decision index is calculated based on

cost to implement, time to implement, risk to implement and return on investment to implement

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15-25). Therefore, it would have been obvious at the time of the invention to incorporate the

established solutions of Sanders into Machin et al's gap analysis system to provide

recommended solutions and best practices for industry metrics that can be easily accessed based

on the gap analysis. The access of the established solutions would simplify and quicken the gap

analysis procedure.

As per claim 31, it is the system for performing the method of claim 29. Therefore, since

Machin et al teaches a computer system, the same rejections as applied to claim 29 is applied to

claim 31.

Claims 32 and 33 are directed to the program product stored on a recordable medium for

performing the method of claims 29 and 30. Therefore, since Machin et al teaches a computer

system, the same rejections as applied to claims 29 and 30 are applied to claims 32 and 33.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL
2/23/07

Primary Examiner
Art Unit 3623